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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,884	11/13/2001	Hiroyuki Onishi	U 013711-6	5111

140 7590 12/09/2005

LADAS & PARRY  
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NEW YORK, NY 10023

EXAMINER
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FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/009,884

Applicant(s)

ONISHI ET AL.

Examiner

William P. Fletcher III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,8-10 and 67-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-10 and 67-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-15-05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 Oct. 2005 has been entered.

### ***Response to Amendment***

2. Claims 1 and 4-69 are pending, of which claims 4-7 and 11-66 are withdrawn from consideration.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 15 Jul. 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Response to Arguments***

4. Applicant's arguments, see the response, filed 17 Oct. 2005, with respect to the rejection(s) of claim(s) 1, 9, 10, and 67 under 35 USC 102(b) and the rejection of claim 8 under 35 USC 103(a), have been fully considered and are persuasive. Specifically, as noted at page 3 of the Office action mailed 26 Jul. 2005, Shimamura teaches only a hetero-ring-containing thiol compound. Because applicant has amended independent claim 1 to delete this species, Shimamura no longer applies. Therefore, the rejection has been withdrawn. However, upon

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further consideration, a new ground(s) of rejection is made in view of Ishida et al. (US 5,480,768 A).

*Allowable Subject Matter*

5. The indicated allowability of claims 68 (and, by extension, new claim 69) is withdrawn in view of the newly discovered reference(s) to Ishida et al. (US 5,480,768 A). Rejections based on the newly cited reference(s) follow.

*Claim Rejections - 35 USC § 102*

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. **Claims 1, 8-10, and 67-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishida et al. (US 5,480,768 A).**

With respect to claims 1, 68, and 69, Ishida teaches a conventional process for treating a photographic element having a latent image thereon (anticipates claimed “recorded matter comprising a recording medium in which images are recorded”) is treated with a composition containing thiosulfuric acid. Further, Ishida offers, as an explicit example of an additional component of the composition, a thiocyanate. See 1:1-2:40 and 38:6-18.

With respect to claim 8, Ishida offers, as explicit examples of additional components of the composition, nitrogen-containing compounds (36:10-46).

With respect to claim 9, insofar as one may write on a photographic element (i.e., photograph) with a pen, marker, etc., the photographic element of Ishida anticipates applicant’s claimed ink receiving layer disposed on a support.

With respect to claim 10, Ishida teaches that the photographic element may be dipped into the composition (1:37-42), which anticipates applicant's claimed "immersion treatment." Broadly speaking, since the composition must necessarily come into contact with the surface of the photographic element, this anticipates applicant's claimed "coating treatment" as well.

With respect to claims 67 and 69, the image is fixed on the photographic element after contact with the composition. Insofar as a developed and fixed photographic image is no longer sensitive to light (i.e., it cannot be exposed/developed again), this teaching anticipates applicant's claimed improved light resistance. Insofar as any coating layer (even temporarily) constitutes a physical barrier covering the photographic image, it inherently provides some impediment to impinging gas molecules and hence anticipates applicant's claimed improved gas resistance.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al. (US 5,480,768 A).**

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The teaching of Ishida is detailed above. While this reference anticipates coating treatment in general, and immersion treatment in particular, it is the examiner's position that any convenient means of applying the composition to the photographic element may be employed. Consequently, spray, blowing, and ink jet treatment would have all been obvious to one of ordinary skill in the art.

### *Conclusion*


11. The prompt development of clear issues in the prosecution history requires that applicant's reply to this Office action be fully responsive (MPEP § 714.02). When filing an amendment, applicant should specifically point out the support for any amendment made to the disclosure, including new or amended claims (MPEP §§ 714.02 & 2163). A fully responsive reply to this Office action, if it includes new or amended claims, must therefore include an explicit citation (i.e., page number and line number) of that/those portion(s) of the original disclosure which applicant contends support(s) the new or amended limitation(s).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/6/05  
  
William Phillip Fletcher III  
Patent Examiner, USPTO  
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